

REMARKS

Claims 1-2 and 5-6 were pending in this Application as of the Office Action of February 23, 2009. Claims 1 and 6 are amended with this Response.

Objection to the Specification and Rejections under 35 U.S.C. 112, first paragraph

The examiner objects to the Specification and rejects claim 6 because the phrase “direct visual authentication of the document” is allegedly not supported by the original disclosure. In Response, Applicant respectfully amends claim 6, and points out that this phrase was not amended into the Description portion of the Specification.

Rejections under 35 U.S.C. 112, second paragraph

Claims 1, 2, 5, and 6 have been rejected under 35 U.S.C. 112, second paragraph for being allegedly indefinite. In response, Applicant respectfully amends claim 1.

Rejections under 35 U.S.C. 102(b)

Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by the United States Publication No. 2001/0006556 to Graves (“Graves” hereinafter). Applicant respectfully traverses.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant’s amended claim 1 recites *inter alia*,

“providing a sales machine which allows a customer to purchase goods and/or services against payment by providing a document as cash in the form of banknotes,

vouchers or the like...and

providing visual verification to an operator when the probability does not meet the predetermined criteria and the document is negatively authenticated, the visual verification including:

recording the document as an image and presenting the image to the operator, accepting the document when the document passes the visual verification, and refusing acceptance when the document does not pass the visual verification”

First, Applicant respectfully notes that Graves does not teach provision a sales machine which allows a customer to purchase goods and/or services against payment by providing a document as cash in the form of banknotes, vouchers or the like. On the contrary, Graves teaches a currency evaluation and recording system that is determined to evaluate banknotes that are provided in form of a stack (please see Graves, page 1, paragraphs 4 to 9). There is no sales machine or sale contemplated in Graves.

Next, Applicant respectfully notes that Graves does not teach providing visual verification to an operator when the probability does not meet the predetermined criteria and the document is negatively authenticated, and thus certainly does not teach the visual verification to include recording the document as an image and presenting the image to the operator, accepting the document when the document passes the visual verification, and refusing acceptance when the document does not pass the visual verification. On the contrary, Graves merely provides indication to an operator that a stack of banknotes may contain counterfeit documents. The corresponding signal that is created by a microprocessor (and recorded) is only taught to be reviewed by an operator in Graves. The Graves operator makes no further decision regarding *acceptance* or *refusal*, as required by Applicant’s amended claim 1 (please see Graves, paragraphs 42 and 82). In fact, the Graves operator is not involved in a decision on acceptance or rejection at all.

For at least the above reasons, Applicant respectfully asserts that Graves does not

teach every element of Applicant's claim 1, or claims 2 and 5-6 that depend therefrom. As such, it is respectfully submitted that Applicant's claims 1-2 and 5-6 are not anticipated by Graves.

Regarding the Examiner's Response to Applicant's arguments and allegation that the last two elements of Applicant's claim 1 (i.e. providing visual verification..., and recording the document...) amount to "optional language," Applicant respectfully notes that MPEP 2106 II C (as cited by the Examiner) states"

"Finally, when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, **the claim as a whole must be considered**. See, e.g., *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981) ("In determining the eligibility of respondents' claimed process for patent protection under § 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. **This is particularly true in a process claim because a new combination of steps in a process may be patentable** even though all the constituents of the combination were well known and in common use before the combination was made.") (emphasis added).

When viewed as a whole, the last two steps in question are **required** by claim 1 to occur when a preceding step (i.e. failure to meet predetermined criteria and negative authentication) recited in the claim is met. As stated above, considering these elements as a whole in the claim is particularly important in a process claim such as Applicant's amended claim 1 because of the manner in which **all** of these elements (i.e. failure to meet predetermined criteria and subsequent visual verification) are combined. For at least these reasons, Applicant respectfully asserts that the Examiner is required to assign patentable weight to the steps.

Claim Rejections Under 35 U.S.C. §103

Claims 1, 2, 5, and 6, are rejected under 35 U.S.C. 103(a) as being unpatentable Graves in view of Applicant Admitted Prior Art (AAPA). Applicant respectfully traverses this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

For at least the reasons discussed above, Applicant respectfully asserts that Graves does not teach or suggest all of the limitations of Applicant's now amended claims 1, 2, 5, and. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claims 1, 2, 5, and 6 with respect to Graves.

With regards to any alleged AAPA, Applicant respectfully notes that generic sales machine devices for public transport vehicles can sometimes suffer from high rejection rates of banknotes because of insufficiencies of the banknotes that often have defects caused by wear, torn papers, and the like. This results in a cumbersome rejection of genuine banknotes by such machines.

In the absence of any specific AAPA cited by the Examiner, Applicant respectfully submits that generic method for a sales machine as discussed above is disclosed by the Protag system. The Protag system differs from the method according to amended claim 1 by

the features of providing a visual verification by an operator when the probability does not meet the predetermined criteria and the document is negatively authenticated, wherein the visual verification comprises recording the document as an image and presenting the image to the operator; accepting the document when the document passes the visual verification, and refusing the acceptance when the document passes not the visual verification. This creates a more powerful method because the operator may view exactly what the problem is with a document. This enables the operator to fell a decision of acceptance.

Protag (as typical of generic methods in general) fails to provide an additional (third) verification method, namely a visual verification by an operator if authentication of the document has been negative. The Protag system does not give any hint to the person skilled in the art to provide a third verification method by an operator.

Referring again to Graves, Graves generally belongs to a different technical field, namely, the evaluation of a stack of banknotes. However, this is different to the technical field of sales machines, which require a direct and fast operation of a single banknote so that the customer can purchase goods and/or services. This is also the reason why Graves does not provide for a decision making operator.

Accordingly, since Graves does not teach every element of Applicant's claims 1, 2, 5, and 6, and any alleged AAPA fails to remedy these deficiencies of Graves, one of ordinary skill at the time of Applicant's invention would not have a motivation to modify Graves in light of AAPA, or a reasonable likelihood of success in forming the claimed invention by modifying Graves in light of AAPA. Thus, here again, *prima facie* obviousness does not exist. *Id.*

As such, the requirements of *prime facie* obviousness does not exist regarding claims 1, 2, 5, and 6 with respect Graves as combined with AAPA.

Conclusion

Applicant hereby petitions under 37 C.F.R. §1.136 for any extension of time required for entry and consideration of this submission.

The Office is invited to contact Applicant's attorneys at the below-listed telephone number concerning this Submission or otherwise regarding the present application.

If there are any charges with respect to this Submission, or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicant's attorneys.

Respectfully submitted,
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